

PATENT

REMARKS/ARGUMENTS

In the outstanding office action, claims 1-34 are pending in the application.
Claim 1-34 are rejected.

Claim Rejections – 35 USC §103

Claims 1-34 are rejected under 35 USC 103(a) as being unpatentable over Ananda (U.S. Patent Number 5,548,645) in view of Wilde et al. (U.S. Patent Number 6,446,260). Applicant respectfully traverses this ground of rejection of the claims on the basis that a *prima facie* case of obviousness has not been established, a requirement established by the Federal Circuit and CAFC case law and PTO regulations, such as MPEP 2142, for instance. Moreover, as will be discussed, amendments made by Applicant to the claims are made for the purpose of clarifying the claimed invention and are not in themselves related to patentability or to this basis of rejection.

There must be a basis in the art for combining or modifying references in a proper *prima facie* rejection. MPEP 2143.01 provides that the mere fact can references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive support the combination. *ACS Hospital Systems, inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

In the case at hand, there is no basis in the art for combining or modifying the references. The primary reference relied upon by the examiner is the Ananda reference. Ananda provides for the remote rental of software by a first computer from a second computer via a communications link only while a continuous connection is maintained (Abstract). There is no discussion or suggestion in the reference of operating systems since a workable, already existing operating system for the first computer is assumed. The Wilde et al. reference, conversely, is concerned with the migration/installation of computer operating systems from a network server/host to
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client workstations (Abstract). There is thus no discussion of applications. The problem sought to be solved by each of these respective references is quite different and Applicant can find no suggestion or teaching towards the combination of the two. Indeed, one may assert that these references actually teach away from their own combination. Because Ananda is concerned with the remote rental of application software, it assumes the presence and good operating condition of some default operating system. Its intended function is not enhanced by the installation/migration of various operating systems as provided in Wilde et al.

Moreover, even if one were to combine the references, Applicant respectfully submits that the combination does not yield the claimed invention. A recitation in each of the independent claims is an operating system associated with an application selected by the user. This association is explained at length in the specification and provides the mechanism by which the invention, once the application is selected, can download and execute both the selected application and associated operating system under which it can run, in a manner that is transparent to the user. All the user has to do is select the desired application (the Detailed Description, including page 9, lines 8-19; and page 10, line 3, to page 11, line 3) and the desired application as well as the operating system associated with it under which it can be run are downloaded, installed and executed.

Applicant has amended the base claims to better clarify the claimed invention. It is believed that these clarifying amendments are not necessary to overcome the 103 rejection over the combination of Ananda and Wilde et al., which has been shown to be a defective basis of rejection as noted above, but rather are being made to better clarify the claimed invention and are not considered to be related to reasons of patentability of the claimed invention. Operation of the boot code and download manager is described at length in the specification at page 5, lines 13-28; page 6, lines 3-18; page 7, line 21 to page 8, line 20; and page 8, line 21 to page 9, line 7, for example. Available applications are presented by the boot code. Following selection of a desired application by the user, the boot code activates the download manager of the client device, which controls the download of the selected application and an associated operating system under which the application can run. These are then installed and executed on the client device. Operation of the boot code and download

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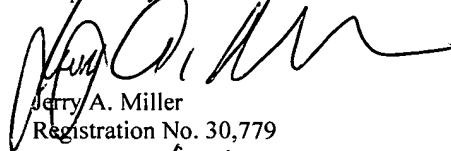
manager are transparent to the user. Page 9, lines 8-19; and page 10, line 3 to page 11, line 3, of the specification. The clarifying claims made to the claims do not constitute new matter or new issues.

Although additional arguments could be made for the patentability of each of the claims, such arguments are believed unnecessary in view of the above discussion. The undersigned wishes to make it clear that not making such arguments at this time should not be construed as a concession or admission to any statement in the Office Action. In an examiner interview conducted on July 29, 2004 with Patent Office Examiners Mark Thompson and Bret Dennison by attorney Renee' Michelle Larson, Reg. No. 361,93, differences between the cited references and the claimed invention were discussed.

If the Examiner believes that there are any informalities which can be corrected by Examiner's amendment or if there are any questions about this filing, a telephone call to the undersigned or Ms. Larson (301-668-3073) is respectfully solicited.

With this amendment, the application is believed to be in condition for allowance and a favorable response at an early date is earnestly solicited.

Respectfully submitted,



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